

REMARKS/ARGUMENT

Description of Amendments

In this Amendment, Applicant amends claims 19, 30 and 36 and adds claims 38-40. No new matter has been added. Upon entry of the Amendment, claims 18 to 40 are pending.

The amendment to claim 19 is supported by the application as originally filed (see, for example, the PCT application at page 5, lines 25-26). The amendment to claim 30 is supported by the application as originally filed (see, for example, the PCT application at Figure 1).

The new claims are also supported by the PCT application (see page 4, lines 6 to 16).

Rejection under 35 U.S.C. §102

Claims 18-23, 26-28, 30 and 32-37 were rejected under 35 U.S.C. §102(b) as being anticipated by McNicholas (U.S. Patent Publication 2003/0195522).

Applicants respectfully traverse the rejection, because McNicholas does not disclose claim 18's limitations of a relaxed, opened position and a stressed, closed position and of an elastic base. The Office Action contended that the insertion cartridge of McNicholas has a relaxed, opened position and a stressed, closed position. But the Office Action failed to point out where McNicholas discloses that the opened position is a relaxed position, and the closed position is a stressed position. McNicholas discloses only that the insertion cartridge has an opened position and a closed position, wherein the opened position is shown in Figure 1 and the closed position is shown in Figure 2. McNicholas does not disclose that any of the two positions is relaxed or stressed. Therefore, the Office Action has not met the initial burden of establishing that McNicholas discloses an insertion cartridge having a relaxed, opened position and a stressed, closed position. "The examiner bears the initial burden ... of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Additionally, McNicholas does not disclose that its insertion cartridge has an elastic base. The Office Action cited a news release by Stanford University to show that the insertion cartridge of McNicholas, made from polypropylene, is elastic. The news release states that polypropylene is a common plastic that has a hard form and a soft form, wherein

the hard form of polypropylene is in the crystalline form. According to the news release, chemists at Stanford were able to create a form of polypropylene that has zero to 30 percent crystallites, resulting in a range of new plastics that vary in elasticity. However, the news release does not state that the chemists were able to increase the percentage of crystallites to above 30 percent. In other words, the disclosed form of polypropylene is closer to the soft form, but not so to the hard form.

The disclosure of the news release does not logically lead to the conclusion that the insertion cartridge of McNicholas is elastic. This merely establishes that the insertion cartridge of McNicholas could be stiff or elastic. Under *In re Oetiker*, the PTO has the burden to establish the insertion cartridge of McNicholas is elastic. The evidence provided by the Office Action does not meet this burden.

Although the above discussion is sufficient to establish that McNicholas does not disclose an elastic insertion cartridge, it should be pointed out that the evidence shows that the insertion cartridge of McNicholas is not elastic. The insertion cartridge of McNicholas is made of a polymer, such as polypropylene, and has a loading chamber and a lumen connecting the loading chamber and the open distal mouth of the cartridge (see the Abstract). The cartridge is an integrally formed, for example, molded, unit (see paragraph [0025]). In other words, the lumen of the cartridge is made of the injection molded polymer (see paragraphs [0025] and [0044]). The wall thickness of the lumen formed by the injection tube is between 0.0045 inches and 0.006 inches (see paragraph [0044]).

The polypropylene described in Stanford's news release has elasticity similar to that of natural rubber and synthetic elastomers. This type of polypropylene is not suitable for use as the material for the insertion cartridge of McNicholas, in particular, for the lumen of the cartridge. The wall thickness of the lumen formed by the injection tube is between 0.0045 inches and 0.006 inches (see paragraph [0044]). If it is made of a material with the elasticity of natural rubber and synthetic elastomers, the lumen of the cartridge is too soft to perform the function of the insertion cartridge, such as to be inserted into an eye through an incision in the eye, and would render the insertion cartridge inoperable. See MPEP 2121 (when the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable). Therefore, the only form of polypropylene suitable as the material for the insertion cartridge is the stiff form.

In view of the above discussion, Applicants respectfully submit that claim 18 is not anticipated by McNicholas. Dependent claims 18-23, 26-28, 30 and 32-37 are also not anticipated by McNicholas, because they depend from claim 18.

Additionally, the dependent claims also recite features not disclosed by McNicholas. For example, claim 26 recites that “the lens holder does not project out of the bearing part.” The lens holder of claim 26 includes an elastic base. Under patent law, the lens holder is not limited to the elastic base and may include other components. Claim 26 does not state that only the elastic base does not project out of the bearing part. Instead, it states that all of the lens holder’s components, whether they are recite in claim 26 or not, do not project out of the bearing part. Under this proper claim construction, the subject matter of claim 26 is clearly not shown in Figure 4 of McNicholas. In Figure 4 of McNicholas, the wings of the insertion cartridge are outside of the alleged bearing part. Therefore, McNicholas does not disclose the subject matter of claim 26.

For another example, claim 28 recites indirectly that “the elastic base in the stressed position forms a channel” and directly that “the channel formed in the stressed position becomes narrower toward one end of the channel.” The Office Action contends Figure 3 of McNicholas shows this feature. Applicants respectfully disagree.

In the rejection of claim 18, the Office Action contends that the wings (16, 18) of McNicholas correspond to the elastic base of claim 18 and that the injection tube (14) of McNicholas corresponds to the cannula of claim 18. In McNicholas, the wings (16, 18) defines a first lumen (52), and the injection tube (14) defines a second lumen (54) (see paragraphs [0029] and [0030]). In other words, the Office Action considers the first lumen (52) of McNicholas to be the channel of claim 28, which is defined by the elastic base. McNicholas discloses only that the second lumen (54) is tapered but does not disclose that the first lumen (52) is tapered (see paragraphs [0029] and [0030]). Therefore, McNicholas does not disclose the feature of claim 28 that “the channel formed in the stressed position becomes narrower toward one end of the channel.” Accordingly, McNicholas does not disclose the subject matter of claim 28.

Additionally, claim 33 recites a connecting mechanism that holds the lens holder in its closed position. The Office Action contended that paragraph [0025] of McNicholas discloses this feature. Applicants respectfully disagree.

Paragraph [0025] of McNicholas recites that “a first member 16 and a second member 18 which are secured or joined together and are hingeably moveable relative to each other along line 21....” It is clear from Paragraph [0025] of McNicholas that it is the hinge that secures or joins the first and second members. However, the hinge cannot secure and join the first and second members in the closed position. There is nothing in the insertion cartridge of McNicholas that can hold the first and second members in the closed position. Accordingly, McNicholas does not disclose the subject matter of claim 33.

Rejections under 35 U.S.C. §103

Claims 24 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over McNicholas. Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over McNicholas in view of Ott (U.S. Patent 6,447,520). Claim 31 was rejected under 35 U.S.C. §103(a) as being unpatentable over McNicholas in view of Tourrette (U.S. Patent Publication 2005/0125000).

Claim 18 is patentable over McNicholas. Ott and Tourrette do not cure the deficiency of McNicholas with respect to claim 18 so claim 18 is patentable over the combination of McNicholas and Ott and the combination of McNicholas and Tourrette. Therefore, claim 24, 25, 29 and 31 are patentable over the combinations for the same reason as claim 18.

New claims 38-40

Claims 38-40 are patentable over the cited references for the same reasons that claims 18-27 are patentable over the cited references. Additionally, the new claims recite additional patentable features. For example, claim 40 recites an elastic base that is deformable from a relaxed, open position into a stressed, closed position, wherein the elastic base is essentially plane in the relaxed, open position and forms a channel in the stressed, closed position. This feature is not disclosed by the cited references.

Conclusion

In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If necessary to effect a timely response, this paper should be considered as a petition for an Extension of

Application No. 10/590,972
Amendment dated September 8, 2009
Reply to Office action of June 5, 2009

Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 07-1850.

Respectfully submitted,

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